



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,857	07/24/2000	Steven D. Clark	4547-8	5123

7590 05/06/2002

Douglas W. Massinger
Massinger Law Office
113 North Olive Street
Media, PA 19063

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
----------	--------------

1713

DATE MAILED: 05/06/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

T.D-7

Office Action Summary	Application No.	Applicant(s)	
	09/621,857	CLARK ET AL	
	Examiner	Art Unit	
	Judy M. Reddick	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. *The following is a quotation of the second paragraph of 35 U.S.C. 112:*

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. *Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

A) *The recited "urethane-based thickener" per claim 1 constitutes indefinite subject matter as per the metes and bounds of such engender an indeterminacy in scope.*

B) *The recited "sulfonate-containing mixture" per claims 1 and 4 constitute indefinite subject matter as per the metes and bounds of such engender an indeterminacy in scope.*

C) *The recited "overbased" per claims 4 and 6 constitute indefinite subject matter as per said term engendering an inconsistency with art-recognized terminology.*

D) *The recited "linear alcohol/hydrocarbon mixtures" per claim 5 constitutes indefinite subject matter as per it not being readily ascertainable as to whether "linear alcohol mixtures", "hydrocarbon mixtures" or "mixtures of a linear alcohol and a hydrocarbon" are intended.*

E) *The recited "wherein said alkaline earth metal sulfonate is calcium overbased sulfonate structurally modified to contain crystalline calcium carbonate" per claim 6 engenders ambiguous and confusing claim language. Does applicant intend a mixture of calcium sulfonate + calcium carbonate or else?*

Claim Rejections - 35 USC § 112

Art Unit: 1713

3. *The following is a quotation of the first paragraph of 35 U.S.C. 112:*

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. *Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specific urethanes as housed in Table 1, does not reasonably provide enablement for compounds falling within the broad scope of the claimed "urethane based thickener". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.*

Allowable Subject Matter

5. *Claims 1-10 are deemed allowable over the prior art of record as per reasons given in the previous Office Action (paper no. 4, 09/20/01). The claims would be allowed if rewritten, amended and/or satisfactorily rebutted so as to obviate the 112 issues raised supra.*

Response to Arguments

6. *Applicant's arguments filed 02/20/02 have been fully considered but they are not persuasive.*

While Counsel, in a good faith effort, attempted to remedy the 112, 2nd paragraph issues, some remain and new 112, 1st and 2nd paragraph issues were discovered and/or created and are as set forth supra.



Creation date: 03-01-2004
Indexing Officer: DDERBY - DAVID DERBY
Team: OIPEBackFileIndexing
Dossier: 09621857

Legal Date: 11-06-2002

No.	Doccode	Number of pages
1	LET.	4
2	A...	1
3	CLM	2
4	REM	7
5	XT/	4

Total number of pages: 18

Remarks:

Order of re-scan issued on